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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,806	10/01/2001	Darrell T. McKenzie	DANA-138	3402

23599 7590 10/23/2002

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EXAMINER

CECIL, TERRY K

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/23/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

14-3

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,806	<b>Applicant(s)</b> MCKENZIE, DARRELL T.	
	<b>Examiner</b> Mr. Terry K. Cecil	<b>Art Unit</b> 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because of the following reasons:

- The following reference signs mentioned in the disclosure are not shown in the drawings:

“10” (page 4). See 37 CFR 1.84(p)(5).

Applicant is required to submit a proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. Objections to the drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities:

- The ABSTRACT is too long (greater than 150 words)

Appropriate correction is required.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities:

- in claim 1, “an” should be added before “annular” (first occurrence) in each of lines 6 and 7;

Appropriate correction is required.

### ***Claim Rejections - 35 USC ' 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hultgren et al. (U.S. 3,369,666), hereinafter "Hultgren". Hultgren discloses a combination filter element support and anti-prefill valve comprising the following:

- a unitary body (the entire invention as shown in figure 2, *see the examiner's note on the next page*) including
  - (i) an annular portion 48 that includes an annular shoulder (adjacent the leader of "54") extending radially to support the filter endcap 42,
  - (ii) a sealing section 50 including sealing ring 51 engaging the end plate 18 at an area coaxial and surrounding the central spin-on opening, and
  - (iii) a radially extending plate portion 62 having an axially positioned one-way valve 76 that opens in an axial direction toward the spin-on opening [as in claim 1];
- a hollow core defined by tube 38 receiving the annular portion therein [as in claim 2];
- a filter cartridge 12 in combination with the unitary body and including an annular filtering element having an annular filtering media 16 for filtering engine oil [as in claims 7, 8 and 9];
- a one-way valve that is a purse valve 76 that includes a pair of lips 78 that project away from the hollow core; are joined by side wall web portions 82 (as shown in both figure 2 and figure 3); that biasingly intersect along a line 80; and that open in response to fluid pressure [as in claims 3 and 4];

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- a plate portion 62 located at the end of the annular second 52, opposite the sealing section 50 and spaced from the annular shoulder to form a chamber for receiving the one-way valve [as in claims 5 and 10]; and
- a unitary body that is made of rubber (col. 4, line 9, *see the examiner's note below*) [as in claims 6 and 11].

**Examiner's note:** the examiner considers the body of figure 2 to be *unitary* since Hultgren describes the combination as being "integral" or as a "single unit" (see col. 3, lines 45-46). Applicant has not defined "unitary" otherwise. Also, Hultgren is considered to anticipate claims 6 and 11 since portion 76 is made of rubber and the claims do not require the unitary body be made *entirely* of rubber. However, it is pointed out that Turman (already of record) teaches a unitary body 78 integrally molded of rubber (col. 2, line 60) and including a purse valve portion, an annular portion 80, and a radially extending shoulder portion 82 for supporting the filter element.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed **terminal disclaimer** in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


7. Claims 1, 2, 9, and 11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 13 and 14 of copending Application No. 09/965,805. Although the conflicting claims are not identical, they are not patentably distinct from each other because the aforementioned claims of the instant application are anticipated by the claims of the copending application and because anticipation is the epitome of obviousness. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 3-8 and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 13 and 14 of copending Application No. 09/965,805 in view of Hultgren. As shown above, Hultgren anticipates claims 3-8 and 10. It would have been obvious for the invention of claims 10 and 13 to include the lips that intersect along a line and to have the plate portion spaced from the radial flange support at the end of the annular portion opposite the sealing area, since Hultgren teaches the benefit of a combination of valves that can be readily inserted into an oil filter as a single unit (col. 1, line 70 to col. 2, line 1). This is a provisional obviousness-type double patenting rejection.

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9. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- Fax numbers for this art unit are as follows:
  - i. (703)872-9310 for *official* faxes (i.e. faxes to be entered as part of the file history) that are not after-final; and
  - ii. (703)872-9311 if after-final.

TKC   
October 21, 2002

Examiner Terry Cecil  
A.U. 1723